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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/447,259	11/23/1999	JAMES D. MARKS	3042/0G691	3586

7590

12/01/2003

DARBY & DARBY P.C.
805 Third Avenue
New York, NY 10022

EXAMINER

JEANTY, ROMAIN

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 12/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/447,259

Applicant(s)

MARKS ET AL.

Examiner

Romain Jeanty

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on 08 September 2003.

2a) ☐ This action is **FINAL**.

2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1,4,6-9,40,43-49,52,54-57,88 and 91-208 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1,4,6-9,40,43-49,52,54-57,88 and 91-208 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some * c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.

4) ☐ Interview Summary (PTO-413) Paper No(s) _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. This Office action is in response the Election mailed November 8, 2003. Applicant's argument with respect to the Election/ Restriction of the of paper number 21, has overcome the Election/Restriction. Therefore, the Election/Restriction of paper number 21 has been withdrawn. Claims 1, 4, 6-9, 40, 43-49, 52, 54-57, 88 and 91-208 are pending in the application.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1, 40, 49, 88, 97-98, 119, 132, 137, 141, 149, 156, 176 and 194 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 1, the limitation of "identifying the questions with a discrete group of open questions for the expert and at least one of the open questions... each of the open questions similarly designated..." is not supported by the specification. The examiner is unable to find where such limitation is disclosed in the specification. Therefore, one skilled in the art would not know how to make and/or use the invention.

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Regarding claims 40, 49, 88, 98 and 194 the limitation of “includes the questions as one of a set of open questions being separately grouped and identified as open questions for the expert to answer...” is not supported by the specification. The examiner is unable to find where such limitation is disclosed in the specification. Therefore, one skilled in the art would not know how to make and/or use the invention

Regarding claims 97, 149, 156 and 176, the limitation of “... unique to the expert and includes the questions as one of a set of open questions routed to the expert to based on a request...” is not supported by the specification. The examiner is unable to find where such limitation is disclosed in the specification. Therefore, one skilled in the art would not know how to make and/or use the invention

Regarding claim 119, the limitation of “.... includes the questions as one of a set of open questions being grouped and identified as open questions for the expert to answer...” is not supported by the specification. The examiner is unable to find where such limitation is disclosed in the specification. Therefore, one skilled in the art would not know how to make and/or use the invention.

Regarding claim 132, the limitation of “ at least two of the questions being identified with a discrete group of open questions for the expert to answer... routing the questions to the expert based on request from two different users” is not supported by the specification. The examiner is unable to find where such limitation is disclosed in the specification. Therefore, one skilled in the art would not know how to make and/or use the invention

Regarding claims 137 and 141, the limitation of “the questions being presented to the expert as open questions the expert to answer...” is not supported by the specification. The

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examiner is unable to find where such limitation is disclosed in the specification. Therefore, one skilled in the art would not know how to make and/or use the invention

Claims 4, 6-9, 43-49, 52, 54-57, 91-96, 99-118, 120-131, 133-136, 138-140, 142-148, 150-155, 157-175, 177-193 and 195-208 are necessarily rejected as being dependent upon the rejected independent claims above.

4. Claim 49 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 49 recites the limitation "the selected" in line 5. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

6. Claims 132, 137 and 141 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per claims 132, 137 and 141, for a claimed invention to be statutory, the claimed invention must be within the technological arts and provide a concrete tangible result. The claimed invention does not provide a concrete tangible result. It is noted that the claimed invention is not a product for performing a process, nor is it a specific machine or manufacture.

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The claimed invention is not a specific tangible machine or a process for providing a plurality of users with communications with an expert **in order to obtain answers to a plurality of answers**. The invention of claims 132 does not include a post process activity or a pre-computer process activity. Thus, no physical transformation is performed and the claimed invention does not provide a useful tangible result such as “providing answers to a plurality of questions to a plurality of users”. Consequently, claims 132 is analyzed based upon the underlying process, and are thus rejected as being directed to a non-statutory process.

Claims 133-136, 138-140, 142-148 are necessarily rejected as being dependent upon the rejected independent claims above.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed Romain Jeanty whose telephone number is (703) 308-9585. The examiner can normally be reached Monday-Thursday from 7:30 am to 6:00 pm. If attempts to reach the examiner are not successful, the examiner's supervisor, Tariq R Hafiz can be reached at (703) 305-9643.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

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Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

or faxed to: (703) 305-7687

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,

Arlington VA, Seventh floor receptionist.

A handwritten signature in black ink, appearing to read "Romain Jeanty". The signature is stylized with a large, sweeping initial "R" and a cursive "Jeanty".

Romain Jeanty

Patent examiner

November 29, 2003